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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/651,979	08/31/2000	Adrian Shields	8490.00	3073

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EXAMINER

PYZOCHA, MICHAEL J

ART UNIT PAPER NUMBER

2137

DATE MAILED: 02/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/651,979	SHIELDS, ADRIAN	
	<b>Examiner</b>	<b>Art Unit</b>	
	Michael Pyzocha	2137	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 January 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 21-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date: _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date: _____  | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

1. Claims 21-38 are pending.
2. Appeal Brief filed on 01/26/2006 has been received and considered. Prosecution has been reopened.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 21-23, 33-34 and 38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. The term "some" in claims 21, 33 and 38 is a relative term which renders the claim indefinite. The term "some" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. For the purpose of applying prior art the term "some" will be considered as "one or more".

Art Unit: 2137

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 21-34 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yacobi (US 5878138) and further in view of Menezes et al (Handbook of Applied Cryptography).

As per claims 21 and 33, Yacobi discloses a portable computer, with non-secure user-accessible memory (see column 8 lines 39-49) generating a session key (see column 9 line 47); encrypting the session key (see column 9 lines 49-50); transmitting the encrypted key to an external terminal (see column 9 lines 53-54); receiving and decrypting an encrypted response from the terminal (see column 9 line 65 through column 10 line 31).

Yacobi fails to disclose a) storing records of events experienced by the computer in memory within the computer; and using some of the records as seed for generating plain text of a first session key K1.

Art Unit: 2137

However, Menezes et al teaches storing records of events and using the records as a seed for generating a key (see page 172).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to use Menezes et al's key generation to generate the session key of Yacobi.

Motivation to do so would have been to generate a random bit sequence for a key (see page 171).

As per claims 22, 24, 26-30, and 38, the modified Yacobi and Menezes et al system further includes repeating the above mentioned steps to create a new session key for each new transaction (see Yacobi column 10 lines 38-47) and receiving and decrypting encrypted messages encrypted by the session key (at both the portable computer and the external device) (see Yacobi column 9 line 65 through column 10 line 31).

As per claims 23, 25, 31-32, and 34, the modified Yacobi and Menezes et al system further includes the data used as the seed includes at least one element selected from the following group: recorded button selections, recorded pointer movements, recorded data entered by a user, current date setting, and current time setting (see Menezes page 172).

8. Claims 35-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over the modified Yacobi and Menezes et al system

Art Unit: 2137

as applied to claims 21, 24, and 26 above, and further in view of Kawan (US 20020062284).

As per claims 35-37, the modified Yacobi and Menezes et al system fails to include the portable computer requires entry of a Personal Identification Number, PIN, prior to generation of the encryption key, and will not complete the transaction without the PIN

However, Kawan teaches the requirement of a PIN (see paragraph 30).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to require a PIN to perform the actions of the modified Yacobi and Menezes system.

Motivation to do so would have been to verify the user (see paragraph 30).

### ***Response to Arguments***

9. Applicant's arguments with respect to the art applied to claims 21-28 have been considered but are moot in view of the new ground(s) of rejection.

10. Applicant's arguments filed 01/26/2006 have been fully considered but they are not persuasive. Applicant argues: the "some of the records" is not unclear.

Art Unit: 2137

Regarding Applicant's argument that the "some of the records" is not unclear; the use of the word "some" in this phrase makes it unclear as to how many of the records are used if any at all. As defined by Answers.com some is, "Being an unspecified number or quantity." By this definition it is unclear how many records are used and one of ordinary skill in the art would not know how many records would suffice the require randomness in creating a key. Furthermore, Applicant's own specification uses the phraseology, "one or more" on page 1 lines 19-22. Examiner recommends the phraseology "one or more of the records", as used in the specification, in place of "some of the records." Also Applicant submitted claim 2 of US patent 5288949 as evidence that the office allows the use of the word "some" in a claim, however, this case has no relation to the present application.

### **Conclusion**

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hind et al (US 6980660 B1) teaches requiring a PIN before a transaction occurs and before a key is generated.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael

Art Unit: 2137

Pyzocha whose telephone number is (571) 272-3875. The examiner can normally be reached on 7:00am - 4:30pm first Fridays of the bi-week off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MJP

  
EMMANUEL L. MOISE  
SUPERVISORY PATENT EXAMINER